



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,408	05/18/2005	Naoyuki Mochida	P27937	6002
52123 7590 09/02/2010 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER NGUYEN, TRAN N				
ART UNIT 3626		PAPER NUMBER		
NOTIFICATION DATE 09/02/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary

Application No.

10/535,408

Applicant(s)

MOCHIDA, NAOYUKI

Examiner

Tran Nguyen

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19, 21, 22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19, 21, 22, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/26/2010 has been entered.

Response to Amendment

As per the Office Action mailed 05/26/2010:

The rejection of claim 19 under 35 USC 112, fourth paragraph is hereby withdrawn in view of Applicant's amendment to claim 19.

As per the rejection of claims 1-19, 21-25 under 35 USC 101, this rejection is hereby withdrawn in part with respect to claims 18-19, 23 in view of Applicant's amendment to claims 18-19 and cancellation of claim 23. The remainder of this rejection with respect to claims 11-17, 21-22, 24-25 is hereby maintained in view of Applicant's failure to adequately traverse this rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 11-17, 21-22, 24-25 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, this claim recites a "server" comprising a "requester that receives, by a receiver".

The receiver is not positively recited as being a structural limitation of the claim.

Insofar as the "requester" is concerned, the broadest and most reasonable interpretation of this limitation would envelop software *per se* embodiments.

Similar rationale applies to the remaining structural limitations of the claim.

Therefore, the claim comprises software *per se* structure, and is found to be nonstatutory.

All claims dependent thereon, namely claim(s) 12-17, 21-22, 24-25, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 11-12, 15-19, 21, 24-25 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Menschik (20050027995) in view of Gokhale (GriT: A CORBA-Based GRID Middleware Architecture) and Edelson (5737539).

As per claim 11, Menschik teaches a system capable of facilitating (reads on "relay server") file transfer (reads on "service delivery") between a user computer (reads on "client terminal") , wherein the user computer connects to a central server (reads on "the session") (Figure 14) and then connecting directly to the source computer (reads on "an application session different from the session") to transfer or view a file (reads on "delivers a service directly to the client terminal") (Figure 16-17).

Menschik does not teach an SIP session.

Gokhale teaches using an SIP session (page 8 column 2 Section 2.3.5) to share medical data (page 2 column 1 paragraph 2).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Gokhale within the embodiment of Menschik with the motivation of providing distributed applications (Gokhale; page 1 column 2 paragraph 1).

Menschik further teaches:

(a) software on the central server (reads on "a requester") capable of receiving a request from the user computer, wherein the request comprises data identifying a particular patient (reads on "service request information") (Figure 14);

(b) software on the central server (reads on "an authenticator") capable of registering and authenticating the user computer (Figure 12-13);

(c) software on the central server (reads on "a searcher") capable of searching a database representing source computers containing thereon data requested by the user computer (Figure 14);

(d) software on the central server (reads on "a service inquiry layer") capable of determining which source computer(s) containing the requested data (Figure 14).

Menschik does not explicitly teach contacting the source computer directly to inquire if the source computer can provide the requested data.

Edelson teaches that if a patient is not found in the indexed directory located at the central host computer, searching all remote computers directly to determine if any of these remote computers contain the requested data (column 8 line 50-54).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Edelson within the embodiment of

Menschik and Gokhale with the motivation of providing data for patients not listed in the directory (Edelson; column 8 line 51-54).

Menschik further teaches:

(e) software (reads on "a response layer") capable of providing the source computer(s) containing the requested patient data to the user computer (Figure 14);

(f) software (reads on "a confirmation relay") capable of connecting the user computer directly to the source computer (Figure 15-16) (It is noted that the key and other data used to establish a direct connection is considered to be "a confirmation request").

Regarding the SIP session being active while the data is streamed, this feature is found in Gokhale (page 8 column 2 Section 2.3.5).

Additionally, the SIP is an extremely well known layer of the Internet Protocol, as is evident by Gokhale. Therefore, the combined teachings of the applied art suggest this limitation.

As per claim 12, the user computer is capable of specifying which patient (reads on "client information") and whether to receive or view (reads on "service content") (Figure 14).

As per claim 15, this claim is rejected for substantially the same rationale as applied to claim 11 above, and incorporated herein.

In particular, Applicant has not defined the scope of "session change request including service change information".

Additionally, the claimed system would function in the same manner regardless of the descriptive label attributed to the inputted data.

Indeed, the claim only requires that the system receives request data and queries a computer if the received request data may be accommodated. As such, the contents of the received request data do not materially affect the functionality of the claimed system, i.e. the claimed system would function in the same manner regardless of the type of request data received by the system. Regardless of the contents of the request data, the system simply queries a computer to determine if the computer can perform the requested data functions.

To the extent Applicant would argue that the applied art do not teach a particular claimed data, the distinction is a matter of the content of the information, that is, descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate (here the system). See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994). *In re Ngai*, 367 F.3d at 1338. See also, *Ex parte Mathias*, 191 Fed. Appx. 959 (CCPA 2006).

In that regard, Applicant has not come forward with evidence sufficient to show that the structure of the claimed system is functionally affected by the data inputs as in the applied art. Absent such evidence, it is reasonable to conclude that the claim limitations to generic data are descriptive and not functionally related to any structure of

the claimed system and as such falls under the category of patentably inconsequential subject matter. See *Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative) ("Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.).” See also *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative).

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. In *re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. In *re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

As per claims 16-17, Menschik teaches that the system is capable of connecting to a plurality of source computers (Figure 16).

As per the set of claim(s): 18, 19, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 11, 11, respectively, and incorporated herein.

As per claim 21, Menschik teaches indicating an error when authentication fails (Figure 14) and when transfer fails (Figure 16-17).

As per the set of claim(s): 24, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 13, respectively, and incorporated herein.

As per claim 25, Menschik teaches that any source computer can request documents for themselves (Abstract and throughout).

Similar rationale as applied to claim 15 also applies here, as discussed above and incorporated herein.

Claim(s) 13-14 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Menschik in view of Gokhale and Edelson as applied to parent claim 11 above,

and further in view of Crowcroft (Differentiated end-to-end Internet services using a weighted proportional fair sharing TCP, mailed 05/26/2010).

As per claim 13, Menschik teaches connecting to the source computer (Figure 15-16).

Menschik, Gokhale, and Edelson do not teach receiving a disconnection signal and billing based on the connection duration.

Crowcroft teaches billing a user based on the duration of a connection (page 63 paragraph 1). It is noted that duration calculation suggests that a start time and a finish time are used to determine duration. This suggests the disconnection signal.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Crowcroft within the embodiment of Menschik, Gokhale, and Edelson with the motivation charging the user for Internet usage (Crowcroft; page 62 Section 5).

As per claim 14, this claim is rejected for substantially the same rationale as applied to claim 13 above, and incorporated herein.

In particular, since all functionality are known, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the known functionality on any known computer without materially affect the functionality.

Claim(s) 22 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Menschik in view of Gokhale and Edelson as applied to parent claim 11 above, and further in view of Rodriguez (Parallel-Access for Mirror Sites in the Internet, mailed 05/26/2010).

As per claim 22, Edelson in view of Gokhale and Menschik teaches searching a plurality of sites, as discussed above and incorporated herein.

Menschik, Gokhale, and Edelson do not teach canceling a request when one source has been found.

Rodriguez teaches a plurality of computers hosting the same document (page 1 column 1 paragraph 2). Rodriguez further teaches shying away from slow computers towards a faster computer (page 1 column 2 paragraph 2).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Rodriguez within the embodiment of Menschik, Gokhale, and Edelson with the motivation connecting to a fast server to complete the transfer.

Response to Arguments

Applicant's arguments filed 08/26/2010 have been fully considered but they are not persuasive.

On page 11 Applicant asserts:

In the present amendment, Applicant has amended independent claim 11 to recite specific, meaningful physical features of Applicant's server that further clarifies that Applicant's independent claim 11 is directed to statutory subject matter, and is not merely an abstract idea. These meaningful physical features at least include specific references to a receiver, a transmitter, a controller, and a network.

As discussed above, these features have not been positively recited as structural limitations of the claimed system. Therefore, they do not limit the claim to these structures. Instead, the claim only requires possibly software *per se* structures capable of interacting with these hardware devices.

On page 13 Applicant asserts:

As a result of the specific configuration and operation of the relay server discussed above, Applicant's claimed relay server provides a distinct advantage over previous systems. As recited in Applicant's specification, "According to this configuration, in a session establishment stage, the relay server carries out user authentication, and therefore the application server need not carry out user authentication and it is possible to easily construct the application server. Furthermore, the relay server can improve the utilization efficiency of the user authentication function owned by the relay server itself and reduce operation costs by collecting a fee from the application server, etc." (See Applicant's specification page 5, lines 10-18.

The SIP protocol is extremely well known. According to Gokhale, an SIP session is established directly between two computers, i.e. in an *ad hoc* manner. No pre-negotiated security is required from the central server.

Therefore, the asserted advantages do not distinguish the claimed invention from the applied art.

On page 14 Applicant argues:

Applicant respectfully submits the specific combination of features recited in each of amended independent claims 11, 18, and 19 are distinctly different from MENSCHIK and EDELSON. The amended independent claims inquire of a single specified "searched" application server (that is, relays an SIP session establishment request to the searched application server), whereas EDELSON searches for patients that are not listed in a directory service, at "all" remote computers and does not restrict the inquiry targets.

The claim recites "comprising". Therefore, the scope of the claim can envelop additional unrecited steps.

As long as the applied art discloses searching in the manner as recited at one computer (as discussed above), the fact that the applied art repeats the steps at additional computers is not germane to the rejection.

If Applicant intends for searching to be done at only a single computer, Applicant should amend the scope of the claim accordingly.

Applicant's arguments on page 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert W. Morgan can be reached on 571-272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tran Nguyen/

Examiner, Art Unit 3626

08/30/2010